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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,444	03/26/2004	Sotomitsu Ikeda	02922.000205.	8112

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FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER
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KANE, CORDELIA P

ART UNIT	PAPER NUMBER
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2132

MAIL DATE	DELIVERY MODE
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10/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/809,444

Applicant(s)

IKEDA, SOTOMITSU

Examiner

Cordelia Kane

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau. (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/26/04, 7/12/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to the non-provisional application filed on March 26, 2004. Claims 1 – 10 are pending. Claims 1 and 10 are independent.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Nobuyuki Teraura's US Publication 2002/0170973 A1. Referring to claims 1 and 10, Teraura teaches:

- a. An identification apparatus that identifies a recording medium to which the contents information is to be outputted (page 5, paragraph 90).
- b. A first determination method that determines whether or not the output of the contents information to the recording medium identified is permitted (page 5, paragraph 89).
- c. A second determination method that determines whether or not the contents of the information designated for output has been registered (page 5, paragraph 92).

- d. An output apparatus that outputs the contents information designated for output to the recording medium based on the determination by the first and second determination methods (page 5, paragraph 92).
4. Referring to claim 2, Teraura teaches a management apparatus that controls the contents information outputted and the identification of the recording medium (page 5, paragraphs 90 and 92).
5. Referring to claim 3, Teraura teaches that the determination by the first and second determination devices is carried out in cooperation with the management apparatus (page 5, paragraph 89, 90 and 92).
6. Referring to claim 6, Teraura teaches an output apparatus responsive to the first determination device determining that the output of contents information to the recording medium is not permitted, for not outputting the contents information designated for output, regardless of the determination by said second determination device (page 6, paragraph 96).
7. Referring to claim 7, Teraura teaches an information processing apparatus that designates the contents for output (page 5, paragraph 92).
8. Referring to claim 9, Teraura teaches:
  - e. The recording medium has a radio section attached thereto (page 5, paragraph 90).
  - f. The identification apparatus identifies the recording medium by reading the identification information sent from the radio section (page 5, paragraph 92).

For the control circuit to know to select the paper tray with the RFID tag paper in it, it would have to read the RFID.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 4, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura as applied to claim 1 above, and further in view of Tsuboi et al's US Patent 4,958,221. Teraura discloses all the limitations of the parent claim as well as:

- g. An output apparatus responsive to said first determination device determining that the output of the contents information to the recording medium is permitted and said second determination device determining that the contents information designated for output has been registered, for outputting the registered contents information (page 5, paragraphs 89 and 92).

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12. Teraura does not explicitly disclose the document not being registered inhibiting the printing of it, and the content information for output already being outputted to the medium. However, Tsuboi discloses:

h. That the output apparatus still outputs the image even if the image is not registered (column 22, lines 47-52).

i. That the output apparatus does not output the image if it is not registered (column 21, lines 65-66).

j. That the content for output has already been outputted (column 23, lines 33-40).

13. Teraura and Tsuboi are analogous art because they are from the same field of endeavor, copying and printing. At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Teraura and Tsuboi before him or her, to modify Teraura to include the registration and mosaic method of Tsuboi. The motivation for doing so would have been to print multiple copies of the same image with slightly different color settings so as to be able to locate the one that is the best fit (column 1, lines 52-67).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cordelia Kane whose telephone number is 571-272-7771. The examiner can normally be reached on Monday - Thursday 8:00 - 5:00 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CPK

Cordelia Kane  
Patent Examiner  
Art Unit 2132

/Benjamin Lanier/  
Benjamin Lanier  
Examiner Art Unit 2132